

**REMARKS**

Claims 2 through 5 have been amended to correct typographical errors present in the claims as originally filed.

Applicant respectfully traverses the Examiner's rejection of claims 1 through 5 under 35 U.S.C. § 103(a) as being unpatentable over Lagerway et al., U.S. Patent No. 5,774,271, in view of Lehrer, U.S. Patent No. 6,604,847. Applicant's invention is not obvious in light of Lagerway et al. and Lehrer because, as the Examiner points out on page 2 of the Office Action, the Lagerway et al. reference does not disclose the use of a LED light and, more importantly, any light mounted inside the small housing. The Lagerway light is mounted in a separate housing far from the head-mounted light housing and requires an extensively long fiber optic cable from the light source. Applicant's LED light source is in the mounted housing and, therefore, provides lightweight but high-intensity light at the source. This combination is not disclosed in Lagerway. Lagerway, et al. teaches a complex headlamp assembly having a condensing lens group disposed in a separate box far away from the housing mounted on the doctor's head. Lehrer merely describes a simple LED light mounted within a housing and having a single lens for projecting the light, said LED light assembly being capable of being attached to a head band. There is no structure for high-intensity optics. Neither prior art reference cited by the Examiner contains any suggestion to modify the inventions described by the references in the manner set forth by the Examiner. Clearly, the Examiner is attempting to apply the "obvious to try" test to the Applicant's invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the “obvious to try” test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the “obvious to try” test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that “obvious to try” is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453, 455 (C.C.P.A. 1967). Therefore, the Examiner’s assertion that the Applicant’s invention is obvious due to the Examiner’s own belief, in hindsight, that the Applicant’s use of the LED light and power source was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant’s claims under 35 U.S.C. § 103(a). The prior art references cited by the Examiner do not teach, disclose, or suggest the modification of a physician’s surgical headlamp to include a LED light connected to a power source as a source of light as is claimed in independent claims 1 and 5 of the present application.

In Ex parte Obukowicz, 27 U.S.P.Q. 2d 1063 (Bd. Pat. App. & Interf. 1992), the Board of Patent Appeals and Interferences stated:

[T]he specific statement by [the prior art reference] is not a suggestion [to modify the references as asserted by the Examiner]. At best, the [prior art reference] statement is but an invitation to scientists to explore a new technology that seems a promising field of experimentation. The [prior art reference] statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach “obvious to try” but it does not make the invention obvious.

Invitations to explore and general guidance as to the particular form of the invention found within the prior art are insufficient grounds for determining an invention to be obvious

under 35 U.S.C. § 103(a). As the Examiner states on page 2 of the Office Action, the Lagerway et al. reference does “not teach the use of the power source and the LED light source.” Moreover, the Lehrer reference provides “only general guidance as to the particular form of the claimed invention or how to achieve it.” In re Roemer, 258 F.3d 1303, 1310-1311 (Fed Cir. 2001), citing In re O’Farrell, 853 F.2d 894, 903 (1988). The Lehrer reference does not teach, disclose, or suggest the use of a LED light in combination with a complex physician’s surgical headlamp that includes an iris aperture disposed between a condensing lens group and an exit lens group. The suggestion of the Lehrer reference to use a LED light as the light source for a surgical headlamp may have been obvious to try, but the suggestion of “obvious to try” does not render the Applicant’s invention obvious.

Claims 2 through 4 depend on independent claim 1 of the invention, and therefore, include all of the limitations disclosed in Applicant’s claim 1. With respect to claim 2, the inclusion of a means for attaching the headlight housing to a head band to be worn by a surgeon would not be obvious to one skilled in the art where that means for attaching is connected to a novel and previously unknown surgical headlight system that includes a lens assembly in optical communication with a fiber optic rod as well as a LED light and power source as disclosed in claim 1 of the invention. With respect to claim 3, the use of a LED light with a white color light temperature of 5,500 kelvins (K) would not be obvious to one skilled in the art where said LED light of 5,500 K is connected to a novel and previously unknown surgical headlight system as disclosed in claim 1. Additionally, Lehrer claims the use of LED lights with a color temperature of

“above about 7000° K” and “above about 8500° K.” See Lehrer, U.S. Patent No. 6,604,847, column 6, lines 23-27; and claims 2, 3, 9, 10, and 14.

With respect to claim 4, the inclusion of a mirror mounted in the light path from the lens assembly to the housing light outlet of the headlight would not be obvious to one skilled in the art where said mirror is used with a novel and previously unknown surgical headlight assembly that includes a LED light and power source as disclosed in claim 1. Because claims 2 through 4 include all of the limitations of independent claim 1, it would not have been obvious to one of ordinary skill in the art to choose the means for attaching, white color light temperature, and mirror disclosed by the Applicant in those claims as components of the headlight assembly for the simple reason that the surgical headlight system with LED light and attached power source was unknown but for Applicant’s disclosure in the application. “[O]ne cannot choose from the unknown.” In re Ochiai, 71 F.3d 1565, 1570 (Fed. Cir. 1995), citing In re Mancy, 499 F.2d 1289, 1293 (C.C.P.A. 1974).

Thus, for the foregoing reasons, the Examiner’s rejection of claims 1 through 5 under 35 U.S.C. § 103(a) cannot be sustained, and the Applicant respectfully requests the Examiner to withdraw these rejections and to enter the Amendment.

In re application of: KLOOTZ, Jack

Serial No.: 10/711,006

Page 8

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry L. Haley", is written over a horizontal line.

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